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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,530	01/26/2001	Takahiro Miyoshi	010032	4911

38834 7590 07/15/2005

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EXAMINER

QIN, YIXING

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/769,530

Applicant(s)

MIYOSHI ET AL.

Examiner

Yixing Qin

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7, 9-13 and 15 is/are allowed.
- 6) ☒ Claim(s) 8, 14 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

In response to applicant's amendment received 2/03/05, all requested changes have been entered. New claims 15-16 have been added. Claim 14 has new matter issues as discussed below.

The amendment filed 02/03/2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: claim 14 recites that the print control number can be directly inputted into the printer. There is insufficient support from the description of the invention for this part of claim 14.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Response to Arguments***

Regarding claims 1-7 and 9-13. The Examiner agrees with the Attorney and is allowing those claims. Claims 15 is allowed since it is dependent on an allowed claim. Please see the reasons for allowance below. Claims 14 and 16 have unresolved new matter and 112 issues.

Regarding claim 8, the Examiner understands the Attorney's argument that the amendment of adding the words "in advance" into the claims indicates that the print data is converted into image data before a print command is issued. However, the way the claim is written, "in advance" is insufficient in describing the argument being made.

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The data could be converted into imaging data "in advance" to, for example, print job completion, which would be inherent. The Examiner has kept the same rejection as before.

### ***Allowable Subject Matter***

Claims 1-7 and 9-13, and 15 are allowed. The reason for allowance that that these claims are related to a printing system in which the printing of data through the use of a control number assigned to that data. No prior art has been found to disclose the generation of a control number at a computer, storing the print information and image data in the printer, and printing the image data that is being specified by a print control number.

Claim 16 would be allowable if the claim is amended to overcome 112 issues discussed below.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As mentioned above in the arguments, the words, "in advance" renders the claim indefinite as it does not point out in advance to what the conversion process takes place.

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Claim 16 is also rejected as per claim 8 above, as limitation four of claim 16 also states "converting in advance..."

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

I. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda (U.S. Patent No. 6,791,703).

#### **8. Claim 8 (Currently Amended)**

**A printer comprising:**

- **a control portion that accesses a Web page based upon an address of the Web page that is provided from outside, obtains data, and converts in advance the data into imaging data;**
- the concept of an operation section ("**a control portion that accesses a Web page**"). Maeda teaches in Fig. 15 (item 331) and column 12, lines 25-29, that "... (t)he domain name of a WWW server to be accessed and the file name of the HTML data are to be obtained ("**obtains data**") are displayed in URL key 331 ("**an address of the Web page that is provided from outside**") ...". This technique is done in the "operation section" ("**control portion**") (Fig. 1, item 5), which needed to perform web pull printing in Maeda's system (column 6, lines 49-55).

Furthermore, in column 5, lines 64-67, Maeda discloses that "(t)he PDL data (which is one of the forms of data that could be acquired) are developed into image data by the formatter 6..." (i.e. **converts the data into imaging data.**)

The amendment of adding the words "in advance" is insufficient in describing the invention as it is unclear (from the claims) that in advance to what function or process or event the conversion of data takes place. This could simply be "in advance" to, for example, completion of the print job.

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- **a memory that stores the imaging data; and**
- **a hard disk (i.e. a memory that stores the imaging data).** In column 4, lines 48-50, Maeda discloses that "a hard disk (i.e. "memory") 3, [stores] image data..."
- **an image-forming portion that prints the imaging data in response to a print execution command that is provided from outside and specifies the imaging data.**
- **a core, for data transfer and a printer for "image-forming."** The print utility provides the "**print execution command and the specific image data**" as discussed in the last limitation of claim 7 above. Maeda discloses in column 6, lines 10-14, that a "...core 2 can control the transmission of data among the [various components]...and can perform a compound process, such as the reading of a document, the printing of an image..." The **image forming portion** is disclosed in Fig. 1, item 8 as well as column 4, line 57 as "a digital image printer."

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yixing Qin whose telephone number is (571)272-7381. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571)272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YQ

  
EDWARD COLES  
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